Remarks

Claims 1, 8, 14-16, 23, 25, 30 and 36-38 have been amended to more precisely claim the present invention. Claims 67 and 68 have been added. No claims have been canceled. Claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68remain pending in the application.

Priority Claim

The Examiner raised an issue as to whether the present patent application disclosure and the present claims 1, 3, 8, 14-16, 23, 25, 30 and 36-38 can claim priority to the filing dates of the provisional application 60/110,952 and the non-provisional application 09/372,253. The Examiner generally cited the requirements of 35 USC 112, first paragraph in support of this issue of priority claiming. More specifically, the Examiner stated that the subject matter of currently amended independent claims 1 and 23 is not supported by the priority documents in that permitting download of the file based on a number of attempted downloads of the file by the user and the number of successful downloads of the file by the user is not supported.

The Applicant respectfully disagrees with the Examiner on this issue and would like to point out several instances in the provisional application 60/110,952 where support for the present claims can be found. Support of the claims involving permitting a limited number of downloads is found in the provisional application 60/110,952 (hereafter '952 Application) in several places. See for example, the text in '952 Application, Appendix A, page 3, last paragraph. Also, see for example, the text in '952 Application, Appendix B, page 4, first full paragraph. In addition, see for example, the text in '952 Application, Appendix C, page 3, third full paragraph.

In addition, the non-provisional application 09/372,253, like the present patent application, specifically incorporates by reference all of the text and drawings of the provisional application. As such, the support for claims 1 and 23 found in the '952 Application is also in the parent non-provisional application 09/372,253.

Therefore, the Applicant respectfully requests reconsideration and withdrawn of the objections to the priority claim and the pending claims 1, 3, 8, 14-16, 23, 25, 30 and 36-38 under 35 USC 112, first paragraph.

35 U.S.C. §101

Claims 1, 3, 8, and 14 through 16 were rejected under 35 USC 101 as being directed to non-statutory subject matter. In particular, the Examiner stated that the claimed inventions does not fall within the technological art. The Applicant disagrees with the Examiner's assertions concerning non-statutory subject matter of the claims. Independent claim 1 recites claim language regarding downloading of a file from a network. In addition, this file is selectively permitted to be downloaded. As defined in the specification, a file includes a computer readable software application or other data represented in digital form. Also, the network connects end user machines to servers through the Internet or other type of network. Further, downloading is defined as providing a file to an end user machine from a server through a network. Support for these definitions can be found beginning on page 3, line 11 through page 29, line 6. These elements of claim 1 are clearly produce a useful, concrete, and tangible result that is a downloaded file from a network. In view of the foregoing, the Applicant requests reconsideration and withdrawal of the rejection of claims 1, 3, 8, and 14 through 16 under 35 USC 101 as being directed to non-statutory subject matter.

35 U.S.C. §103

Claims 1, 3, 8, 14-16, 23, 25, 30, and 36-38 were rejected under 35 USC §103(a) as being unpatentable over Downs '618 in view of Pitts '248. In the October 4, 2004 Office Action and more specifically to page 11, the Examiner stated that "Downs does not teach permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user." The Applicant agrees with this assessment of Downs '618.

The Examiner cited Pitts '248 with particular reference to column 5, line 4 to column 6, line 33. The Examiner stated that Pitts '248 teaches, in analogous field of endeavor, the downloading of Pay per view TV programs to remote terminals and permitting such download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. For several reasons, the Applicant respectfully disagrees with this characterization of Pitts '248 and its use in combination with Downs '618.

First, all the rejections cited under §103(a) cite Pitts '248; however, this reference is not prior art, but rather nonanalogous art, and may not be relied upon as a basis for rejection of the applicant's invention. In order to rely on a reference as a basis for rejection of Applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F2d 1443, 1446, 24 USPQ 2d 1443, 1445 (Fed. Cir. 1992). MPEP 2141.01(a). Applicant's invention, as claimed, relates to downloading of software over a network such as the Internet. In contrast, Pitts '248 relates to cable television systems having a pay per view function. Clearly, Pitts '248 field of study in cable TV does not relate to the Applicant's endeavor in software downloading, as claimed. In addition, Pitts '248 is not reasonably pertinent to the problems addressed by the Applicant in fraud protection for software downloading, because Cable TV taught by Pitts '248, would not logically have been considered by the Applicant when considering the problems of the Applicant's invention, as claimed.

Second, Pitts '248 is a non-enabling reference. Pitts '248 fails to teach the downloading of anything, even a TV program. Pitts '248, in column 5, lines 10-17, discloses authorizing a viewing of a pay per TV program and storing that authorization to view. Pitts '248, in column 6, lines 14-24 discloses downloading a credit limit and initialization data . Nowhere in the Pitts '248 reference does it suggest the actual download of a TV program and furthermore no apparatus is disclosed that could store and access such a TV program at a later time. Even if Pitts '248 were used to modify Downs '618, the Examiner's proposed modification would render the cited references being modified unsatisfactory for its intended purpose. Here, if the second reference, Pitts '248, were used in combination with the primary reference, Downs '618, the proposed modification would render the Downs '618 reference unsatisfactory for its intended purpose. Applicant respectfully submits it would not be obvious to one or ordinary skill in the art at the time the invention was made to know how to modify Downs '618 by limiting downloads of software based on whether a credit limit had been exceeded by the user as taught by Pitts '248. In fact, Pitts '248 does not teach limiting downloads based on number of times that they were downloaded in the past at all, but only permits viewing of a TV program when it has been paid for or if a credit limit has been exceeded. The proposed combination of Downs '618,

when combined with Pitts '248, still fails to accomplish the intended purpose of the claimed invention, namely to permitting download of a file based on a number of attempted downloads of that file by the user.

Third, Downs '618 and Pitts '248 to not suggest that either reference should be combined with the other and the Examiner fails to offer any reason to combine the references or at least the reasoning offered in the office action presents an insufficient suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the cited reference teachings. The Applicant wishes to remind the Examiner that any assertion of obviousness may not be based on improper hindsight reasoning. The judgment of obviousness over these references appears to take into account more knowledge than what was within the level of ordinary skill in the art at the time the claimed invention was made, and appears to include additional knowledge gleaned only from the Applicant's disclosure.

In summary, the Applicant respectfully suggests that the Examiner has failed to establish a *prima facie* case of obviousness. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine the reference teachings. In addition, the cited references, when combined, fail to teach or suggest all the claim limitations. The necessary teaching or suggestion to make the claim combination and the reasonable expectation of success is not both found in the cited references. Applicant respectfully suggests that Downs '618 and Pitts '248 when considered individually or together in combination, fail to suggest or teach all of the elements of the presently pending claims. For example, neither Downs '618 nor Pitts '248 teach, as presently claimed in independent claims 1 and 23, permitting download of the file based on a number of attempted downloads of the file by the user. Also, neither Downs '618 nor Pitts '248 teach permitting download of the file based on a number of successful downloads of the file by the user.

Claims 3, 8, and 14-16 depend from claim 1 and therefore are allowable over Downs '618 and Pitts '248 for the same reasons that claim 1 is allowable. Claims 25,30, 36-38 depend from claim 23 and therefore are allowable over Downs '618 and Pitts '248 for the same reasons that claim 23 is allowable.

Therefore, under 35 USC §103(a) Downs '618 and Pitts '248 fail to teach the present invention as claimed in claims 1, 3, 8, 14-16, 23, 25, 30 and 36-38 and a withdrawal of this objection is respectfully requested.

Conclusion

On the basis of the foregoing, Applicant respectfully submits that claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 are now believed to be in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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